

REMARKS

Claims 12, 15-17, 20-22, 25-27, 30 and 31 are pending in the present application.

Telephone Interview

Applicant respectfully acknowledges the courtesy extended by Examiner Pizarro during the telephone interview conducted on May 13, 2009. During the telephone interview, Applicant's representative presented arguments against the rejection under 35 U.S.C. 112, first paragraph. The Examiner acknowledged that the presented arguments appeared persuasive. The Examiner however requested presentation of the arguments in a Request for Reconsideration, and cautioned that detailed consideration of the application and the rejection under 35 U.S.C. 112, first paragraph would be necessary, as well as reconsideration of the prior art of record. The content of the discussion during the telephone interview will be reflected in the following comments.

Claim Rejections – 35 U.S.C. 112

Claims 12, 15-17, 20-22, 25-27, 30 and 31 have been rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner has asserted that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey that the inventor had possession of the claimed invention. The Examiner has asserted that the

description in the original disclosure fails to support the features of a protective layer made of a polyimide resin that is a UV-sensitive tape comprised of a hardened synthetic resin that bonds the UV-sensitive tape to the second surface of the semiconductor element. This rejection is respectfully traversed for the following reasons.

The semiconductor device of claim 12 includes in combination among other features a protective layer "made of polyimide resin on the second surface of the semiconductor element,...wherein the protective layer is a peelably removable UV sensitive tape comprised of a hardened synthetic resin that bonds the tape to the second surface of the semiconductor element".

In the paragraph bridging pages 4-5 of the current Final Office Action dated March 3, 2009, the Examiner acknowledged that the specification 1) supports a protective tape that is a hardened synthetic resin such as polyimide resin, and 2) supports a protective tape that could be peeled away from the back surface of the chip by UV irradiation.

The Examiner however subsequently asserted that

"However, the fact that the tape could be removed using UV irradiation does not mean that the tape itself is UV sensitive. The specification only describes that the tape is removed using UV irradiation, not that the tape per se is in any way sensitive to UV irradiation".

As discussed in the telephone interview and as noted above, the Examiner has acknowledged that the tape can be peeled using UV irradiation. One of ordinary skill

would generally understand this to mean that the UV irradiation breaks down the adhesive bonds of the hardened synthetic resin, rendering the tape removable by peeling. That is, the UV light affects the tape so that once it is irradiated, the resin breaks down and no longer bonds the tape to the second surface of the semiconductor element.

Thus, it should be clear that the protective layer as featured in claim 12, which is a peelably removable UV sensitive tape which is open-endedly comprised of a hardened synthetic resin, is indeed sensitive to UV light or irradiation. Clearly, if the peelably removable UV sensitive tape was not sensitive to UV light, the tape would not be removable after being exposed to UV light.

Applicant respectfully submits that the specification reasonably conveys that Applicant had possession of a protective layer that is a peelably removable UV sensitive tape comprised of a hardened synthetic resin. Accordingly, Applicant further respectfully submits that the semiconductor device of claim 12 is in compliance with 35 U.S.C. 112, first paragraph, and that this rejection of claims 12, 15 and 16 is improper for at least these reasons.

The semiconductor device of claim 17 includes in combination among other features a protective layer "made of polyimide resin on the second surface of the semiconductor element,...wherein the protective layer is a peelably removable UV sensitive tape which comprises a hardened synthetic resin that bonds the tape to the second surface of the semiconductor element". Independent claims 22 and 27 each

respectively include somewhat similar features.

Applicant respectfully submits that respective claims 17, 22 and 27 are in compliance with 35 U.S.C. 112, first paragraph, and that this rejection of claims 17, 20-22, 25-27, 30 and 31 is improper for at least somewhat similar reasons as set forth above.

Conclusion

The Examiner has acknowledged in the paragraph bridging pages 3-4 of the current Office Action that claims 12, 15-17, 20-22, 25-27, 30 and 31 would be allowable upon overcoming the rejection under 35 U.S.C. 112, first paragraph. Since claims 12, 15-17, 20-22, 25-27, 30 and 31 should be considered as in compliance with 35 U.S.C. 112, first paragraph for the above reasons, the Examiner is respectfully requested to reconsider and withdraw the corresponding rejection, and to pass the claims of the present application to issue.

In the event that there are any outstanding matters remaining in the present application, please contact Andrew J. Telesz, Jr. (Reg. No. 33,581) at (571) 283-0720 in the Washington, D.C. area, to discuss these matters.

Serial No. 10/800,693
KKH.041D2
Request for Reconsideration dated May 26, 2009

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment for any additional fees that may be required, or credit any overpayment, to Deposit Account No. 50-0238.

Respectfully submitted,

VOLENTINE & WHITT, P.L.L.C.

/Andrew J Telesz Jr/

Andrew J. Telesz, Jr.
Registration No. 33,581

11951 Freedom Drive, Suite 1260
Reston, Virginia 20190
Telephone No.: (571) 283-0720
Facsimile No.: (571) 283-0740